



UNITED STATES PATENT AND TRADEMARK OFFICE

XLW

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,511	08/15/2001	Ramsay Wood		9770

6858 7590 08/12/2004

BREINER & BREINER
115 NORTH HENRY STREET
P. O. BOX 19290
ALEXANDRIA, VA 22314

EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,511

Applicant(s)

WOOD, RAMSAY

Examiner

Alex P. Rada

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3714

DETAILED ACTION

Response to Amendment

In response to the amendment filed April 27, 2004 in which the applicant cancels claims 5 and 6, and claims 1-4 and 7 are pending in this office action.

Drawings

1. The drawings were received on April 27, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith '582.
4. Smith discloses the following:

A pack of playing cards having a set of differentiated face designs on the playing cards (figures 1 and 2), the face designs being a conventional or substantially conventional set of playing cards (column 2, lines 14 – 57), rules to determine a method of game play (column 2, line 60 – column 14, line 65), a number of backs of the playing cards possess marking that are coordinated with the face design found on the playing cards to enable formation of different type of set based on the marking found on the backs of the playing cards, in which the examiner interprets the indicia in figures 2-3 to be an equivalent to the face

Art Unit: 3714

design found on the playing cards to enable formation of different type of set based on the marking found on the backs of the playing cards (figures 2-3) as recited in claim 1.

The marking on the backs of the playing cards (figures 1-6) having an outer portion identical on each card and an inner portion coordinated with the face designs found on the playing cards, in which the examiner interprets the surrounding borders around the numbers and letters to be a functional equivalent to applicant's outer portion identical on each card and an inner portion coordinated with the face designs as recited in claim 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith '582 in view of Brown '698.

7. Smith discloses the claimed invention as discussed above except for the following:

The markings on each of the playing cards are selected indicia to be arranged in a set to of a completed poem, carton strip or a commercial product as recited in claims 3 and 7.

Brown teaches the following:

Art Unit: 3714

The markings on each of the playing cards are selected indicia to be arranged in the form different images (figures 1 and 2). By having indicia arranged to form selected indicia, one of ordinary skill in the art would provide a diverse deck of cards for assisting the improvement of a Childs learning skills by providing simple games of fun.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Smith to include markings on each of the playing cards are selected indicia to be arranged in a set to of a completed poem, carton strip or a commercial product as taught by Brown to provide a diverse deck of cards for assisting the improvement of learning skills of a child by providing simple games of fun.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide a specific pack of playing cards markings because having a pack having 52 cards and the face designs with four suits of ace to king provides the same function as any type of playing cards with rules as taught by Smith, in which Applicant has not disclosed that the a pack having 52 cards and the face designs with four suits of ace to king as recited in claim 4 provides an advantage, or solves a stated problem.

Response to Arguments

8. Applicant's arguments filed April 27, 2004 have been fully considered but they are not persuasive.

Art Unit: 3714

Applicant contends that the Smith reference does not teach a set of cards having conventional playing card marking on one side of the cards.

The examiner disagrees with applicant because the Smith reference does disclose the claimed limitations. Smith discloses a set of playing cards (figures 2-3) having a set of differentiated face designs on the playing cards, the face designs being a conventional or substantially conventional set of playing card markings on one side of the cards (figures 2-3), and a set of rules. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. Therefore, giving the claims their broadest reasonable interpretation, the Smith reference does disclose the claimed limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., conventional playing cards) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3714


the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


APR


JESSICA HARRISON
PRIMARY EXAMINER